

REMARKS

Claims 1, 2 and 9-11 are presented for consideration, with Claims 1, 9 and 11 being independent.

Claim 1 has been amended to further distinguish Applicant's invention from the cited art. In addition, previously-withdrawn Claims 9-11 have amended to include the features of Claim 1. Claims 3-8 and 12-15 are cancelled.

Initially, Claim 1 is rejected under 35 U.S.C. § 102 for allegedly being directed to non-statutory subject matter. In response to this rejection, Claim 1 has been amended to include the changes recommended on page 2 of the Office Action. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

Claim 1 is also rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. It is respectfully submitted that the changes to Claim 1 as discussed above also serve to overcome this rejection. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Disharoon '401. This rejection is respectfully traversed.

Claim 1 relates to a vibrating knife comprising an excision member which is adapted to be brought into contact with a target and vibrated in a direction at an angle to a traveling direction in excision by ultrasonic vibrations so as to excise the target. The excision member includes a first edge formed by sides having hydrophobic surfaces, and a second edge

formed by sides having hydrophilic surfaces and arranged at a position opposite to the first edge. As claimed, when the target is hydrophobic, the first edge is adapted to be used as a leading end edge located on a forward side in the traveling direction to excise the target, and the second edge is adapted to be used as a trailing end edge located on a backward side in the traveling direction to separate the excised target from the excision member. When the target is hydrophilic, the second edge is adapted to be used as the leading end edge, and the first edge is adapted to be used as the trailing end edge.

As well documented, Disharoon relates to a method and apparatus for using a vitreous carbon knife element. As shown in Figures 2 and 3, a knife element 30 includes a vitreous carbon plate 31 having a knife edge 38. The vitreous carbon knife edge is a hydrophobic material, but Disharoon discloses that at least one surface “adjacent” to the edge may be a hydrophilic material (see Column 7, lines 30-38).

In contrast to Applicants’ claimed invention, however, Disharoon does not teach or suggest, among other features, an excision member with a first edge formed by sides having hydrophobic surfaces and a second edge formed by sides having hydrophilic surfaces, wherein the first edge or the second edge can be used as the leading end edge, depending on whether the target is hydrophobic or hydrophilic. In this regard, the Office Action asserts that Disharoon “inherently” suggests four edges, and that knife edge 38 could be considered a second edge having hydrophilic surfaces and a first edge is considered to be an edge formed directly opposite to edge 38 and would have hydrophobic surfaces. It is respectfully submitted, however,

that such a reading goes far beyond the disclosure in Disharoon. As shown in Figure 3, Disharoon provides a single leading end edge, i.e., knife edge 38, as the knife element 30 is stationary on a stage 42. It is respectfully submitted, therefore, that Disharoon cannot reasonably be used as a teaching of providing first and second edges which both serve as a leading end dge. Moreover, Disharoon discloses that a cutting surface must be rendered hydrophilic (see column 7, lines 39-46). Therefore, even if Disharoon were read to teach a second edge, or cutting surface, that second edge would also be hydrophilic, in contrast to Claim 1 of Applicants' invention.

It is respectfully submitted, therefore, that Disharoon fails to anticipate or render obvious Applicants' invention as set forth in Claim 1, and thus reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

As noted above, previously withdrawn Claims 9-11 have been amended to include each of the features set forth in Claim 1. Reconsideration and allowance of these claims is thus also respectfully requested.

Accordingly, it is submitted that Applicants' invention as set forth in independent Claims 1, 9 and 11 is patentable over the cited art. In addition, dependent Claims 2 and 10 set forth additional features of Applicants' invention. Independent consideration of the dependent claim is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

/Scott D. Malpede/

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Scott D. Malpede  
Attorney for Applicants  
Registration No. 32,533

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
SDMjeb

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